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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,150	02/11/2004	Ashutosh Vyas	26530.94	3076

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HAYNES AND BOONE, LLP
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EXAMINER
PANNALA, SATHYANARAYA R

ART UNIT	PAPER NUMBER
2164	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/776,150	VYAS ET AL.
	Examiner	Art Unit	
	Sathyanarayan Pannala	2164	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 September 2008</u>.

2a) ☒ This action is FINAL.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-3,10-14,18-21 and 23-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-3,10-14,18-21 and 23-25</u> is/are rejected.

7) ☒ Claim(s) <u>4-9,15-17 and 22</u> is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   Applicant's Response filed on 9/26/2008. In this Office Action, claims 1-25 are

pending.

Claim Objections

2.   Claims 1-11 are objected under 35 U.S.C. § 101, because none of the claims are

directed to statutory subject matter. Independent claim 1 deal with simple mathematical

abstract ideas and can be achieved with a **paper and pencil**. A process that merely

manipulates an abstract idea or performs a purely mathematical algorithm is

nonstatutory despite the fact that it might inherently have some usefulness. In Sarkar,

588 F.2d at 1335, 200 USPQ at 139. See recent court case, In-Re Comiskey,

_____,Fed. Cir., 2007____ decided 9/20/2007. (see MPEP 2106(IV)(B)(2)(b)(ii)). In this

case, claims 1-11 have to be amended as "computer implemented method" in place of

"method" to overcome the objection.

Specification

3.   The summary of the invention is not included in the specification. The

Background of the invention and Brief summary of the invention must in separate

section. A summary is required that is clearly indicative of the invention to which the

claims are directed. See MPEP §§ 608.01(d).

        The following guidelines illustrate the preferred layout for the specification of a

utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

    (a) TITLE OF THE INVENTION.
    (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
    (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
    (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR
        1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings"
        (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on
        compact discs.) or
        REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices"
        were accepted by the Office until March 1, 2001.)
    (e) BACKGROUND OF THE INVENTION.
        (1) Field of the Invention.
        (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
    (f) BRIEF SUMMARY OF THE INVENTION.
    (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
    (h) DETAILED DESCRIPTION OF THE INVENTION.
    (i) CLAIM OR CLAIMS (commencing on a separate sheet).
    (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
    (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on
        paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR
        1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on
        compact disc).

Claim Rejections - 35 USC § 101

4.   35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of

matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the

conditions and requirements of this title.

5.   Claims 12-19 are rejected under 35 U.S.C. § 101, because none of the claims

are directed to software per se. Independent claim 1 is claiming a computer software

per se and functional descriptive material consisting of data structures and computer

programs, which impart functionality when employed as a computer component. As such, the claims are not limited to statutory subject matter and are therefore non-statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8.

6.   Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific or substantial asserted utility or a well established utility.

        The disclosure does not support the phrase "computer readable medium."

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.   Claims 20- 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "computer readable medium' is not disclosed in the specification.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
>
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
>
> the prior art are such that the subject matter as a whole would have been obvious at the time the
>
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
>
> Patentability shall not be negatived by the manner in which the invention was made.
>
>   This application currently names joint inventors. In considering patentability of the claims
>
> under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was
>
> commonly owned at the time any inventions covered therein were made absent any evidence to the
>
> contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and
>
> invention dates of each claim that was not commonly owned at the time a later invention was made in
>
> order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e),
>
> (f) or (g) prior art under 35 U.S.C. 103(a).

10.   Claims 1-3, 10-14, 18-21 and 23-25 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Harsham et al. (US Patent 6,041,347) hereinafter Harsham, in

view of Nguyen (USPA Pub. 2003/0172145 A1) hereinafter Nguyen and further in view

of Pham et al. (US Patent 7,143,288) hereinafter Pham.

11.   As per independent claims 1, 12 and 20, Harsham teaches a centralized

computer network management system that simultaneously configures and monitors in

a computer network. The network administrator allowed to describe each network

device, computer or groups of network devises and computers can be associated with

one or more rules which define configuration parameters (col. 1, lines 48-57). Harsham

teaches the claimed, if the list is not empty, creating from the list a set of mapped

independent rule blocks (col. 4, lines 25-28). Harsham teaches the claimed, for each

block in the set, attempting to determine a position for the new access rule (Fig. 4, col.

5, lines 64-66). Harsham teaches the claimed, removing from the set those blocks for

which a position cannot be determined and merging the blocks in the set to form a new

independent rule block and inserting the new access rule therein (Fig. 7A-C, col. 7,

lines 57-58, col. 8, lines 19-20). Harsham does not explicitly teach creating a new

independent block if the list is empty. However, Nguyen teaches the claimed, if the list

is empty, creating a new independent rule block and inserting the new access rule

(page 15, paragraph [0434]). Nguyen also teaches the claimed, applying the access

rules in the list to enforce policies and permissions to control access to various network

resources (page 20, paragraph [0508]). Thus, it would have been obvious to one of

ordinary skill in the data processing art at the time of the invention, to have combine the

teachings of the cited references because Nguyen's teachings would have allowed

Harsham's method to provide all types of providers must position themselves for growth

and agility to handle increasing numbers of subscribers, additional services, and

workloads that are more challenging (page 3, paragraph [0030]).

      Harsham and Nguyen do not teach explicitly merging access rules. However,

Pham teaches the claimed, merging the blocks in the set to form a new independent

rule block and inserting the new access rule (Fig. 2, col. 6, lines 31-33). Thus, it would

have been obvious to one of ordinary skill in the data processing art at the time of the

invention, to have combine the teachings of the cited references because Pham's

teachings would have allowed Harsham's method to provide a mechanisms to secure

persistent data that are ultimately reliable and cooperatively manageable (col. 3,

lines 4-6).

12.   As per dependent claims 2, 13 and 21, Harsham teaches the claimed, creating

from the list a set of mapped independent rule blocks comprises selecting all blocks in

the list having at least one rule that is not disjoint with the new access rule (Fig. 7B,

col. 7, lines 59-61).

13.   As per dependent claims 3 and 14, Harsham teaches the claimed, attempting to

determine a position for the new access rule comprises, comparing each existing rule in

the rule block to the new access rule and if all existing rules have been compared

against the new access rule and no determination has been made, determining a

position for the new access rule that is at the end of the block (Fig. 7A, col. 7,

lines 55-58).

14.   As per dependent claims 10, 18 and 24, Harsham teaches the claimed, merging

the blocks in the set to form a new independent rule block and inserting the new access

rule therein comprises: placing all rules from every block in the set which are positioned

ahead of the new access rule in front of the new access rule in the new block and

placing all rules from every block in the set which are positioned after the new access rule behind the new access rule in the new block (Fig. 2, col. 4, lines 33-35).

15.   As per dependent claims 11, 19 and 25, Harsham teaches the claimed, removing an existing rule, wherein the removing includes: searching for the existing rule to be removed based on an identification number associated with the existing rule and removing the rule (Fig. 7A, col. 7, lines 58-59).

16.   As per dependent claim 23, Harsham teaches the claimed, determining which of the new access and existing rules has priority is based at least partly on user determined criteria (Fig. 4, col. 5, lines 64-66).

Allowable Subject Matter

17.   Claims 4-9, 15-17 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Additionally, Applicant must overcome rejection under 35 U.S.C. 112 1st and 2nd paragraphs and 35 U.S.C. 101 and any other objections listed in this Office Action.

Response to Arguments

18.   Applicant's arguments filed on 9/26/2008 with respect to claims 1-25 have been

considered but they are not persuasive and details as follows:

        a)   Applicant argued regarding objection to the Specification as "More

specifically, there is no requirement for a "summary of the invention" in the patent

statute, the rules, or the MPEP."

        In response to Applicant argument, Examiner respectfully disagrees.

Because, MPEP nowhere stated as it is not required and if it is not required it

would have not listed in MPEP 608.02(d).

        b)   Applicant argued regarding claims rejection under 35 U.S.C. 101 as

"Claim 1 has the real world value of protecting network security from intruders. It

is also impossible to apply access rules using a paper and pencil in a way that

enforces policies and permissions to control access."

        In response to Applicant argument, Examiner respectfully disagrees.

Because, Applicant is basically claiming steps and how these steps are

implemented is not disclosed or amended claims accordingly. Applicant merely

arguing general statements will not overcome the rejection of the method claims.

In case of the claim 12, the system claim is rejected as a series of steps without

proper implementation, which are considered as followed in typical software.

        c)   Applicant argued regarding claims rejection under 35 U.S.C. 112, first

paragraph, as "for failing to comply with the written description requirement."

In response to Applicant argument, Examiner respectfully disagrees. Because, Applicant has not considered the basic rules in MPEP and arguing to over come the rejection.

d)   Applicant argued regarding claims rejection under 35 U.S.C. 103 as "It is important to combine references where the references teach away from their combination."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Pham et al. US Patent 7,143,288) teaches as "A data server platform includes a **security file system** layer interposed between the platform operating system kernel and file system" (See Abstract). Harsham et al. (US Patent 6,041,347) teaches as "A centralized computer network management system that simultaneously configures and monitors computers in a computer network. Each network device, computer, or groups of network devices and computers can be associated with **one or more rules** which define configuration parameters" (See Abstract). Finally, Nguyen (USPA Pub.

2003/0172145 A1) teaches as "A **firewall** may add to performance and

scalability issues. Another consideration may be: is the design to include a

router Access Control List (ACL) and packet filters? Many ISPs choose to omit

firewalls and implement router ACL and packet filters instead. Considerations on

whether to implement a firewall or router ACL and packet filters may include one

or more of, but are not limited to, the following: routers are stateless and do not

examine payload, and firewalls are necessary for stateful applications" (par.

[0342 & 0344]). From these citations, it clearly indicates that all three references

are analogues to the current application.

e)   Further, Applicant argued as "In fact, the phrases "access rule" and

"ordered access rule" do not appear anywhere in the Harsham, Nguyen, or Pham

references."

        In response to Applicant argument, Examiner respectfully disagrees.

Because, Applicant claimed ordered list has no significance and every list will

have the order. To meet the requirement of Applicant is "while the elements of

the process are shown in an order, the elements may be performed in other

orders, and/or two or more of the elements may be performed simultaneously or

overlapping" (par. [0553]). Regarding access rules Harsham teaches access

rules (see Fig. 4, element 84, col. 5, lines 64-66) indicates as rules and

procedures for user access. User notified the network administrator to follow

access rules as "a central administrator 80 which receives user input 82 to define

rules, groups and the network organization as indicated at 84." Applicant may be

expecting word to word mapping. Most of the cases it is an impossible situation
to map.

Other references

19.   The following related references not relied upon are:

i)   Mathew et al. (US patent 7,454,508).

Conclusion

20.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
the advisory action. In no event, however, will the statutory period for reply expire later
than SIX MONTHS from the mailing date of this final action.

21.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Sathyanarayan Pannala whose telephone number is
(571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sathyanarayan Pannala/
Primary Examiner, Art Unit 2164

srp
December 13, 2008